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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,452	08/15/2003	John E. Adams	NAC-450	1602

22832 7590 02/07/2006

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/642,452	ADAMS ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/15/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. Claims 10, 13 and 14 rejected under 35 U.S.C. 102(e) as being anticipated by Schuller (2005/0055637) made in the last Office Action of August 15, 2005 has been withdrawn in view of the response filed on November 15, 2005.
2. Claims 11-12 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller in view of Korondi (5702127) has been withdrawn in view of the response.

Response to Arguments

3. Applicant's arguments with respect to claims 10-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuller (2005/0055637).

Art Unit: 1772

Schuller relates to a method of making a label comprising the steps of providing a substrate (114) having a front side and a back side, the back side comprising an adhesive (124), deadening (126) a first portion (under the ink print layer) of the adhesive back side, applying ink (128) to the deadened first portion, contacting the back side with a release liner (132) applying ink (120 or 122) to the front side of the substrate, and forming a label having a back side with a deadened first portion.

The second and the third portion are interpreted by the examiner to be located proximate the first portion as shown by the areas of the label rear surface that are not provided with print (areas outside the ink print area) thereby said portions are provided with adhesive and are proximate the first portion (figure-4B) and separated by perforations. Thus, Sculler also teaches the step of perforating at least a portion between the first portion and the second portion, and between the first portion and the third portion.

Further, Schuller, in paragraph-[0032], teaches that the labels are formed by cutting the substrate into multiple labels without cutting the liner.

The ink defines printed information and the ink on the front surface is colored because the print is visible.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1772

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller in view of Korondi (5702127).

Schuller, as discussed above, fails to teach that the deadening step comprises applying UV-curable solution to the adhesive and curing the solution. Korondi discloses a method of making a label comprises providing a label having two lines of perforations that divides the label sheet into first, second and third portions, providing the first center portion with an UV-curable deadening solution and curing the solution using UV-source (abstract; col.3, line 66 to col. Line 7). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Korondi's teaching or using UV-curable deaden solution for in-situ deadening a first portion of the label back side in the invention of Schuller with the motivation to render said first portion non-tacky and separable from the adhesive portions of the label.

Response to Arguments

8. Applicant's arguments filed November 17, 2005 have been fully considered but they are not persuasive.

Applicant argues that Schuller does not anticipate the claimed invention in that the third portion including an adhesive is not taught by Schuller. This is not deemed to be convincing because Schuller, as discussed above, relates to a label comprising a rear portion with adhesive (figure-4B). As shown therein the area with the print thereon are deadened areas and can include bar code, recipes, etc., while the areas outside of the

Art Unit: 1772

print zones are considered to be adhesive. Said adhesive zones are located on either side of the line of perforations. For example, the adhesive zone on one side of the line of perforations is proximate to the deadened area and separated by said perforations line. The adhesive zone includes, as interpreted by the examiner, the second and the third portions, in the absence of any showing otherwise, because the claimed invention fails to show that the two adhesive portions are not separate.

In response to applicants' arguments regarding the Korondi reference, applicant is informed that Korondi was cited to show that it is well well known in the label art to use UV-curable deadening material and that it would have been obvious to provide deadening material that is UV-curable for in-situ curing of the deadening material to render said portions non-tacky. Hence, the combination of Korondi with Schuller would provide for UV-curing of the solution to form the deadened portion.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the applied prior art of record discussed above.

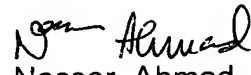
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 2/3/06
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
February 3, 2006.